

Appl. No. 10/773,383
Office Action mailed 11/6/2006

RECEIVED
CENTRAL FAX CENTER

DEC 06 2006

REMARKS

Claims 32-43 and 53-83 are pending.

The Office has required restriction between Species I and Species II. Applicant elects species I with traverse for the below-mentioned reasons. In addition, Applicants respectfully submit all pending claims read on species I.

According to MPEP §806.04(f) (8th ed., rev. 5), it is stated a requirement for restriction may be proper if the species are mutually exclusive. Claims to different species are mutually exclusive if one claim recites limitations disclosed for a first species but not a second, while a second claim recites limitations disclosed only for the second species but not the first. This MPEP section also provides that to require restriction between claims limited to species, the claims must not overlap in scope. The alleged species identified by the Office have not be demonstrated to be mutually exclusive from one another and accordingly the claims are not directed towards different species for which restriction is proper. Applicant respectfully requests withdrawal of the rejection pursuant to the authority of MPEP 806.04(f).

In the instant application, there is overlap of subject matter of the alleged species, and accordingly, restriction of the alleged species is improper under MPEP 806.04(f). In particular, "wafer" is a species of the larger genus "electronic device workpiece" as noted at page 6, lines 11+ of the specification which provides that an electronic device workpiece may be a semiconductor wafer.

Applicants also note dependent claims 43, 78, 80 which further illustrates the relationship of genus and species of electronic device workpiece and wafer. In particular,

S:\W722\2469\W05.wpd A121461261426N

Appl. No. 10/773,383
Office Action mailed 11/6/2005

these claims operate to further define electronic device workpieces as wafers. Accordingly, it is clear that the claims corresponding to the alleged species identified by the Office overlap in scope and the restriction is improper for this additional reason.

Applicant further refers to MPEP 808.02 (8th ed., rev. 5) entitled establishing burden. It is stated in such MPEP section that even if restriction is proper under MPEP §806.05 - 806.06, the Examiner, in order to establish reasons for insisting upon restriction, must explain why there would be a serious burden if restriction is not required. Applicants respectfully submits there is no serious burden as required for proper restriction in view of the significant prosecution of the claims up to this point.

More specifically, Applicant notes the prosecution of the subject application has proceeded as follows:

- First Office Action mailed February 9, 2005 rejecting claims 32-43 and 53-75.
- First Office Action Response mailed June 9, 2005, adding new claims 76-83.
- Notice of Allowance mailed November 16, 2005 allowing claims 32-43 and 53-83.
- Withdrawal from Issue Mailed December 5, 2005 withdrawing allowance of claims 32-43 and 53-83.
- Second Office Action mailed April 10, 2006 rejecting claims 32-33, 37-43, 53-57, 60-64, 67-73, and 75-83 over the prior art.
- Second Office Action Response mailed August 10, 2006.

S:\M\22\2469\M05.wpd A121461261426N

Appl. No. 10/773,383
Office Action mailed 11/6/2006

- Third Office Action mailed November 6, 2006 subjecting claims 32-43 and 53-83 to restriction and/or election requirement.

Accordingly, as set forth above, the Office has searched and examined claims of both groups two previous times. Applicants respectfully submit that there is no serious burden in view of the extensive prosecution, searching and examination of the pending claims.

Furthermore, Applicant further contends that any restriction is improper for at least the following reasons.

First, the Office has apparently already searched and examined the pending claims which are now the subject of restriction. Accordingly, now requiring elimination of any set of claims will not reduce the scope of searching, and thus there are no efficiencies gained by imposing a restriction requirement. In addition, restriction at this late time is not timely, and does not have any sense of fairness to Applicant.

Restriction is not proper since there is increased burden on the U.S. Patent and Trademark Office, on the Applicant and ultimately on the public in prosecuting multiple separate patent applications. For Applicant, splitting the invention into multiple cases increases costs associated with government fees, prosecution fees, and maintenance fees for multiple patents. For the PTO, there are increased costs associated with conducting multiple searches in multiple applications and multiple examinations for an invention that already has been searched and examined. It further ultimately produces a burden on the

Appl. No. 10/773,383
Office Action mailed 11/6/2006

pertinent public that will review Applicant's commonly patented technology. Such people will be compelled to unnecessarily review multiple issued patents and file histories.

Pursuant to MPEP 803 (8th ed., rev. 5), it is stated that *if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions*. In view of the prior two examinations of the present application, Applicant respectfully submits no serious burden exists and Applicant respectfully requests withdrawal of the restriction requirement for this additional reason.

In sum, claims of the alleged species identified by the Office overlap in scope and accordingly restriction is not proper pursuant to MPEP §806.04(f). Restriction is additionally not proper under MPEP 808.02 and MPEP 803 in view of the extensive previous prosecution of the present application including *examination of the claims two previous times on the merits*. Furthermore, the claims which are now restricted were previously allowed by the Office and allowance was withdrawn by the Office. Applicants respectfully submit there is no sense of fairness to now restrict claims which have been extensively prosecuted, allowed and then withdrawn from allowance by the Office and examined again.

Applicant respectfully asserts that the Examiner's restriction requirement is improper, and requests that the restriction requirement be withdrawn and the already examined claims considered in this application at this time.

Applicants request allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes


S:\M\22\2469\M05.wpd A121461261426N

Appl. No. 10/773,383
Office Action mailed 11/6/2006

such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,

Dated: 12/6/06

By: 
James D. Shaurette
Reg. No. 39,833